

60.469-034
OT-4705

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Zaharia
SERIAL NO.: 09/778,481
FILED: 02/07/2001
EXAMINER: Salata, Jonathan
GROUP ART UNIT: 2837
FOR: ELEVATOR INSPECTION DEVICE ARRANGEMENT

13/Response (13)
Chenph
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REQUEST FOR RECONSIDERATION

APR 25 2003

TECHNOLOGY CENTER 2800

Box AF
Assistant Commissioner of Patents & Trademarks
Washington, D.C. 20231

Dear Sir:

Applicant thanks the Examiner for the further remarks and analysis regarding this application provided in the most recent Office Action dated February 26, 2003. Applicant respectfully requests reconsideration of this application.

Applicant respectfully traverses the new rejection under 35 U.S.C. §112, first paragraph. Every figure submitted with the original filing shows a sensor that is spaced from a sheave in the elevator system. The figures taken with the written specification clearly teach that the inspection device is "spaced from the sheave." It is also readily understood by those skilled in the art that the inspection device inspects the portion of the rope that is in the immediate vicinity of the inspection device. Applicant respectfully requests that the Examiner withdraw the new rejection under 35 U.S.C. §112.

The rejection of claims 1-22 under 35 U.S.C. §112, first paragraph, that relates back to the original rejection is, again, respectfully traversed. Applicant urges the Examiner to reconsider the Examiner's position. The many examples provided in the specification and

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the manner in which the placement strategy is described adequately teach one skilled in the art how to practice the claimed invention.

Applicant respectfully traverses the rejection of claims 1, 2, 4-22 under 35 U.S.C. §103 as being unpatentable over the combination of *Yamagami* and *Hirama, et al.* with Applicant's admitted prior art. There is no *prima facie* case of obviousness because there is no motivation for making the combination. Further, even if the combination could be made, it does not satisfy many of Applicant's pending claims.

Applicant is not exactly sure how the Examiner proposes to combine *Yamagami* and *Hirama, et al.* The combination cannot be made without defeating the intended operation of the teachings of the applied references. For example, if one were to substitute the sensor of *Hirama, et al.* for the sensor of *Yamagami*, then the ability of the *Yamagami* arrangement to perform its intended function would be entirely lost. The *Yamagami* reference, as previously discussed, relies upon detecting surface changes in a rope as the rope passes over a sheave. If one were to substitute the inspecting apparatus of *Hirama, et al.*, then the results provided by the *Yamagami* device would be entirely lost. When a proposed combination defeats an intended operation of the primary reference, there is no proper legal motivation for making such a combination and no *prima facie* case of obviousness.

Additionally, if the Examiner is proposing to place the inspecting apparatus of *Hirama, et al.* on the sheave as taught by *Yamagami*, then the inspecting device of *Hirama, et al.* will no longer work. The placement of the device on the sheave as shown by *Yamagami* would render the electromagnetic sensing capabilities of *Hirama, et al.* void because of interference provided by the metallic sheave.

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Lastly, there is no motivation for moving the inspecting arrangement of *Yamagami* into a position as shown for the inspection apparatus of *Hirama, et al.* (i.e., away from the sheave). The teachings of *Yamagami* require the detector 7 to be adjacent the sheave in order for it to work. There would be no motivation to move it away from the sheave because then it would no longer be able to perform the detecting function according to the teachings of that reference.

Regardless of how one tries to combine these two references, there is no motivation for making the combination because one or the other will no longer provide the intended results.

Moreover, at least claims 7, 8, 9, 11, 13 (steps A and B) and 22 (steps A and B) are nowhere shown or suggested within the art. Even if the combination were proper, the result is not the same as at least these claims and any that depend from them. At a minimum, the Examiner must withdraw the rejection under 35 U.S.C. §103 as it pertains to these claims because even if the combination were made it does not satisfy all limitations of the claims.

Applicant respectfully traverses the rejection of claim 3 based upon the combination of *Yamagami* and *Hirama, et al.* with the further addition of *Saito*. As discussed above, there is no motivation for making the combination of *Yamagami* and *Hirama, et al.* The further addition of *Saito* does not remedy this defect in the combination. The explanation provided in paragraph 6 of the Office Action seems to indicate that the Examiner does propose to combine the references such that the detector is placed on the cab sheave. If the combination were made with that placement, it fails to meet the limitations of the claims, which places the inspection device away from a sheave.

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Applicant respectfully submits that this case is in condition for allowance. If the Examiner is not willing to withdraw the rejections under 35 U.S.C. §112 and to otherwise allow this case, Applicant respectfully requests that the Examiner at least clarify the rejection under 35 U.S.C. §103 or withdraw it (even if only regarding some of Applicant's claims) in order to streamline the presentation of issues to the Board of Appeals. Of course, if the Examiner were to withdraw the rejections under 35 U.S.C. §112 and indicate which of the claims are not considered obvious, Applicant will evaluate whether a second appeal is necessary.

Applicant respectfully requests a Notice of Allowance as soon as possible.

Respectfully submitted,

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Dated: April 25, 2003

CERTIFICATE OF FACSIMILE

I hereby certify that this Notice of Appeal is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9319) on April 25, 2003.

Theresa M. Palmatier

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